

**REMARKS**

Claims 1-18, 26, 27, and 31-35 remain pending and under current examination.

By this Amendment, Applicant amends claims 1, 26, and 31 to more particularly define the scope of the invention.

In the Final Office Action<sup>1</sup>, the Examiner rejected claims 1-18, 26, 27, and 31-35 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,513,260 to Ryan (“Ryan”), in view of U.S. Patent No. 5,933,500 to Blatter et al. (“Blatter”), and further in view of U.S. Patent No. 6,839,503 to Hirai (“Hirai”).

Applicant respectfully traverses the rejection and submits that a *prima facie* case of obviousness has not been established. A *prima facie* case of obviousness has not been established because, among other things, none of *Ryan*, *Blatter*, or *Hirai*, taken alone or in combination, teach or suggest each and every element of Applicant’s claims.

Amended claim 1 recites a combination including, for example:

a controlling means for controlling transfer of said content data from said recording medium mounted in said reproducing apparatus to said recording medium mounted in said recording apparatus based on the result of said examination;

wherein said usage space information indicates system information of said recording apparatus and said reproducing apparatus, ownership right information of said content data, format information of said content data, and distributing profit information obtained by the distribution of said content data.

(emphasis added). *Ryan* does not teach these limitations. *Ryan* teaches a CD player that looks for an authentication signature on the CD (col. 2, lines 65-67). If the

---

<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

authentication signature is present, the player will play the CD. If the authentication signature is not present, the player will not play the CD (col. 2, lines 32-44). There is no teaching of a recording apparatus. The Examiner states that black boxes will examine and control transfer substantially as claimed (Office Action at page 2). Applicant disagrees. The black box that the Examiner refers to is external to the CD player and could assist in playing an illegal CD (col. 3, lines 12-16). Even if this black box examines and controls transfer, this box does not record. Rather, the CD has already been recorded and will only be played if the authentication signature is present. Further, *Ryan* does not even use this black box. *Ryan* explicitly states "this copy protection system cannot be compromised by any external black box connected between a CD-player's signal output and a CD-recorder's signal input" (col. 3, lines 12-15). Even if a black box was used, the apparatus would still work in the same manner. Therefore, because the black box is not present, it cannot teach examining and controlling transfer as stated by the Examiner (Office Action at page 2).

In addition, as stated by the Examiner (Office Action at page 2), *Ryan* does not teach a controlling means. *Ryan* does not teach "a controlling means for controlling transfer ... and wherein said usage space information indicates system information of said recording apparatus and said reproducing apparatus, ownership right information of said content data, format information of said content data, and distributing profit information obtained by the distribution of said content data" as required by claim 1.

The Examiner relies on *Blatter* for teaching this controlling means (Office Action at page 3). *Blatter* is directed to a system that allows a user to select between encrypted and decrypted program storage so that the user can view certain programs

(col. 2, lines 2-32). *Blatter* does not teach the claimed examining means for examining a usage space information of the content data, at least because *Blatter* does not teach or suggest usage space information that “indicates system information of said recording apparatus and said reproducing apparatus, ownership right information of said content data, format information of said content data, and distributing profit information obtained by the distribution of said content data” as required by claim 1.

The Examiner relies further on *Hirai* for teaching reproduction and recording means with system control and encryption/authentication (Office Action at page 3). Even assuming that *Hirai* teaches this reproduction and recording means with system control and encryption/authentication, *Hirai* does not cure the deficiencies of *Ryan* and *Blatter*. *Hirai* does not teach usage space information that “indicates system information of said recording apparatus and said reproducing apparatus, ownership right information of said content data, format information of said content data, and distributing profit information obtained by the distribution of said content data” as required by claim 1.

The Examiner alleges motivation to combine *Ryan* with *Hirai* “because the control elements are conventional function equivalents and between reproduction and recording selection a control must always exist” (Office Action at page 3). However, the Examiner states that *Ryan* does not teach a control, but that a committed content duplicator would control the examined files (Office Action at page 2). Even if a duplicator could control the examined files, *Ryan* does not teach this. Therefore, the control means present in *Hirai* is not a conventional function equivalent with *Ryan*.

because *Ryan* does not teach a control means, much less a control means that is equivalent to *Hirai*.

Accordingly, *Ryan*, *Blatter*, and *Hirai* fail to establish a *prima facie* case of obviousness with respect to claim 1, at least because the references fail to teach each and every element of the claim and the references fail to provide motivation for one of skill in the art to combine the references. Claims 2-18 depend from claim 1 and are thus also allowable over *Ryan*, in view of *Blatter*, and further in view of *Hirai*, for at least the same reasons as claim 1.

Independent claim 27, though of different scope from claim 1, recites limitations similar to those set forth above with respect to claim 1. Claim 27 is therefore allowable for at least the reasons presented above.

Independent claim 31, though of different scope from claim 1, recites limitations similar to those set forth above with respect to claim 1. Claim 31 is therefore allowable for at least the reasons presented above. Claims 32-35 depend from claim 31 and are thus also allowable over *Ryan*, in view of *Blatter*, and further in view of *Hirai*, for at least the same reasons as claim 31.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-18, 26, 27, and 31-35 in condition for allowance. This Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment

Customer No. 22,852  
Attorney Docket No. 09812.0625-00  
Application No. 09/803,398

would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

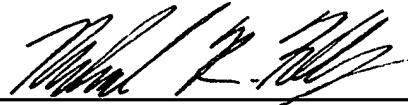
In view of the foregoing remarks, Applicant respectfully requests reconsideration of the application and withdrawal of the rejections. Pending claims 1-18, 26, 27, and 31-35 are in condition for allowance, and Applicant requests a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 21, 2005

By: 

Michael R. Kelly  
Reg. No. 33,921